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10/062,560

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Jerome S. Stern

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EXAMINER

RYMAN, DANIEL J

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,560

Applicant(s)

STERN, JEROME S.

Examiner

Daniel J. Ryman

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10, 12-19, 21-26, 28-33, 35-41, 43, 44, 46-48, and 50-53 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 11, 20, 27, 34, 42, 45 and 49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 22 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 22 appears to be a repeat of claim 21. Therefore, Examiner suggests canceling claim 22.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 8, 14, 16, 17, 24, 31, 37, 39, and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Blair et al (WO 97/27692).

4. Regarding claims 1, 8, and 31, Blair discloses a method of establishing a communication connection between a first terminal (ref. 10 and page 7, lines 5-9) and a second terminal (ref. 28), wherein the first and second terminals are configured for communicating over a primary network (ref. 22: long-distance carrier), the method comprising: receiving at a dial-out unit (ref. 12) a first call setup message from the first terminal over a first signaling channel (as broadly defined the channel between ref. 10 and 12), the first call setup message including an identifier of the second terminal (telephone number of ref. 28) (page 8, lines 9-11); determining whether to establish a communication session between the first and second terminals over an alternative network (ref.

Art Unit: 2665

36: internet) based on the identifier of the second terminal (page 4, lines 10-16) where the farther away the destination of the call the more beneficial using the second network will be due to cost considerations (page 2, lines 8-10); outputting from the dial-out unit (ref. 12) to a dial-in unit (ref. 32), over a data channel (as broadly defined the channel between ref. 12 and 32), the identifier of the second terminal (page 10, line 24-page 11, line 16); and outputting from the dial-in unit (ref. 32) to the alternative network (ref. 36: internet), over a second signaling channel (as broadly defined the channel between ref. 32 and ref. 40), a second call setup message and the identifier of the second terminal (page 4, line 10-page 5, line 8; page 7, line 10-page 8, line 6; and page 8, line 9-page 9, line 11).

5. Regarding claims 14 and 37, referring to claims 8 and 31, Blair discloses that the identifier in the call setup message is an address (telephone number) of the second terminal (page 7, line 2-page 8, line 5 and page 8, lines 15-19).

6. Regarding claims 16 and 39, Blair discloses an apparatus for establishing a call between a first terminal and a second terminal, wherein at least the first terminal is configured for communicating over a primary network (ref. 22: long-distance carrier), by using an alternative network (ref. 36: internet), the apparatus comprising: a terminal port suitable for connecting to the first terminal (ref. 50); a network port (ref. 64) suitable for connecting to a local network (ref. 36); a network protocol unit (ref. 58, 60, 62) connected to the terminal (ref. 50) and network ports (ref. 64) where "connected" is a broad phrase which includes both direct and indirect connections; a processor connected to the network protocol unit (page 11, lines 17-24); and a memory unit connected to the processor, wherein the memory unit includes: an alternative network address storage area configured for storing at least one address for communicating with

Art Unit: 2665

the alternative network (page 11, lines 8-16); a service location storage area configured for storing at least one indicator of a location serviced by the alternative network (page 11, lines 8-16); and an instruction area having stored therein instructions for controlling the processor to determine, based on an identifier of the second terminal contained in a call setup message received from the first terminal by way of the terminal port, if the alternative network services an area in which the second terminal is located (page 10 line 24-page 11, line 21); output from the network port a call setup message addressed to the alternative network in response to determining that the alternative network services an area in which the second terminal is located (page 11, lines 1-4); output from the network port an address of the second terminal (page 4 line 24-page 5 line 8) where since the other exchange completes the call over a telephone line it is implicit that the second address is transmitted so that the call can be completed once it has traversed the internet; and output from the local port a message on the data channel indicating establishment of a connection with the second terminal (page 4 line 24-page 5 line 8) where it is implicit that a message would be output to inform the first terminal that a connection has been established so the call can proceed.

7. Regarding claim 17, referring to claim 16, Blair suggests controlling the processor to output a connect message to the terminal port for indicating to the first terminal establishment of a connection with the second terminal (page 13, lines 12-15 and page 17, lines 3-19) where once a call is able to be completed, it is implicit that the source is informed that a connection is available and the call can proceed.

8. Regarding claim 24, referring to claim 16, Blair discloses having the instruction area includes instructions for controlling the processor to output an indicator of the identify of the

apparatus (page 9, lines 5-8) where it is implicit that IP packets will include a source address as well as a destination address.

9. Regarding claim 51, Blair discloses a method of establishing a communication connection over an alternative network (ref. 36: internet) between first (ref. 10 and page 7, lines 5-9) and second (ref. 28) terminals configured for communicating over a primary network (ref. 22: long-distance carrier), comprising: receiving a first call setup message on a first signaling channel (as broadly defined the channel between ref. 10 and 12), the first call setup message containing an identifier for communicating with the second terminal (telephone number of ref. 28) (page 8, lines 9-11); determining if the identifier in the first call setup message corresponds to a predetermined terminal identifier (page 8, lines 15-19); changing the identifier for communicating with the second terminal (telephone number of ref. 28) with a substitute address (address of remote call over unit 40) for accessing the alternative network (page 10, line 24 to page 11 line 16) ; sending a setup message containing the substitute address to the alternative network (ref. 36: internet); and receiving the setup message, translating the substitute address to the identifier of the second terminal, and establishing a connection with the second terminal over the alternative network (page 4, line 10-page 5, line 8; page 7, line 10-page 8, line 6; and page 8, line 9-page 9, line 11).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692) as applied to claim 1 above, and further in view of Lyon et al (USPN 5,892,924).

12. Regarding claim 2, referring to claim 1, Blair does not disclose that the alternative network is an asynchronous transfer mode (ATM) network; however, Blair does teach that the alternative network is the Internet (page 4, lines 10-20). Lyon teaches that ATM is “a highly efficient packet-forwarding technology with very high throughput, scalability, and support for multiple types of traffic including voice and video as well as data” (col. 2, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to use an ATM network instead of an IP network because ATM offers very high throughput, scalability, and support for multiple types of traffic including voice and video as well as data.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692) in view of Lyon et al (USPN 5,892,924) as applied to claim 2 above, and further in view of Cisneros (USPN 5,130,984).

14. Regarding claim 3, Blair in view of Lyon discloses that the primary network could be an integrated services digital network (ISDN) (Blair: page 9, lines 18-19). ISDN networks are well known in the art as a way to provide increased bandwidth compared to POTS, as is evidenced by Cisneros (col. 1, lines 30-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to use ISDN for the primary network in order to take advantage of the increased bandwidth that ISDN provides compared to POTS.

15. Claims 6, 13, 36, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692) as applied to claims 1, 8, 31, and 39 above, and further in view of Roy (USPN 6,026,080).

Art Unit: 2665

16. Regarding claims 6, 13, 36, and 44, referring to claims 1, 8, 31, and 39 and claim rejections of claims 2 and 3, Blair does not disclose that the first and second terminals conform to ITU-T Recommendation H.320. Roy discloses that ITU-T Recommendation H.320 is a well-known international standard for video teleconferencing for use on an ISDN network (col. 1, lines 27-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to have the first and second terminals conform to ITU-T Recommendation H.320 in order to allow video teleconferencing over the network.

17. Claims 7, 38 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692) as applied to claims 1, 31, and 39 above, and further in view of Ankey et al (USPN 5,113,499).

18. Regarding claims 7, 38, and 46, referring to claims 1, 31, and 39, Blair does not disclose determining, based on the identifier, if the dial-out unit is authorized to use the alternative network, and wherein the dial-out unit outputs the second call setup message only if the dial-out unit is determined to be authorized to use the alternative network. Ankey discloses a processor which determines if a node is authorized to use the network and denies access to the network if the node does not have authorization (abstract). It would have been obvious to one of ordinary skill in the art to check if the user is authorized to use the network in order to prevent unauthorized users from exploiting network resources.

19. Claims 9, 12, 18, 23, 32, 35, 40, 43, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692) as applied to claims 8, 16, 31, 39, and 51 above, and further in view of Cisneros (USPN 5,130,984).

Art Unit: 2665

20. Regarding claims 9, 18, 23, 32, 40, and 52, referring to claims 8, 16, 31, 39, and 51, Blair discloses that the primary network could be an integrated services digital network (ISDN) (page 9, lines 18-19). ISDN networks are well known in the art as a way to provide increased bandwidth compared to POTS, as is evidenced by Cisneros (col. 1, lines 30-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to use ISDN for the primary network in order to take advantage of the increased bandwidth that ISDN provides compared to POTS and thus to use an ISDN dialer for communications.

21. Regarding claims 12, 35, and 43, referring to claims 9, 32, and 40, Blair in view of Cisneros discloses using as the identifier the telephone number of the second terminal (Blair: page 9, lines 18-19 and Cisneros: col. 1, lines 30-36) where, as broadly defined, the ISDN destination address of the second terminal is equivalent to the telephone number of the second terminal.

22. Claims 10, 19, 33, 41, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692) in view of Cisneros (USPN 5,130,984) as applied to claims 9, 18, 32, 40, and 52 above, and further in view of Lyon et al (USPN 5,892,924).

23. Regarding claims 10, 19, 33, 41, and 53, referring to claims 9, 18, 32, 40, and 52, Blair in view of Cisneros teaches that the alternative network is the Internet (Blair: page 4, lines 10-20). Blair in view of Cisneros does not disclose that the alternative network is an asynchronous transfer mode (ATM) network. Lyon teaches that ATM is "a highly efficient packet-forwarding technology with very high throughput, scalability, and support for multiple types of traffic including voice and video as well as data" (col. 2, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to use an ATM network instead of an

Art Unit: 2665

IP network because ATM offers very high throughput, scalability, and support for multiple types of traffic including voice and video as well as data.

24. Claims 15, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692).

25. Regarding claim 15, referring to claim 14, Blair does not expressly disclose that the address of the second terminal includes a country code and said address is determined to correspond to the predetermined location information if the country code corresponds to a country serviced by the alternative network; however, Blair does disclose that the telephone number is used in a long-distance telephone call (page 7, line 2-page 8, line 5 and page 8, lines 15-19). Examiner takes official notice that it is very well known in the art to include a country code with a telephone number when making a long-distance call in order to specify a country for a call. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the address of the second terminal include a country code and to have the address be determined to correspond to the predetermined location information if the country code corresponds to a country serviced by the alternative network in order to allow calls to be placed to a specific country.

26. Regarding claims 21 and 22, referring to claim 16, Blair does not expressly disclose controlling the processor to receive changes to the at least one indicator of a location serviced by the alternative network. Examiner takes official notice that it well known in the art to be able to receive changes of location serviced by a network in order to allow changes in the network to occur. For instance, telephone numbers are capable of being changed and when the number changes the system has to be able to recognize the geographic position by a new address. Thus it

Art Unit: 2665

would have been obvious to one of ordinary skill in the art at the time of the invention to allow the system to adapt to changes in the indicator of a location serviced by an alternative network in order to permit the system to be able to change and adapt to those changes.

27. Claims 25, 29, 30, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692) in view of Movshovich (USPN 5,608,425).

28. Regarding claims 25 and 47, Blair discloses instructions for a device for establishing a call between a first terminal (ref. 10 and page 7, lines 5-9) and a second terminal (ref. 28), wherein at least the first terminal is configured for communicating over a primary network (ref. 22: long-distance carrier), by using an alternative network (ref. 36: internet), the instructions comprising: instructions for determining, based on an identifier of the second terminal (telephone number of ref. 28) contained in a call setup message received from the first terminal (page 4, lines 10-20) by way of the terminal port (ref. 50), if the alternative network services an area in which the second terminal is located (page 10, line 24 to page 11, line 16); instructions of outputting from the network port (ref. 64) a call setup message addressed to the alternative network in response to determining that the alternative network services an area in which the second terminal is located (page 11, line 25); and instructions for outputting from the network port an address of the second terminal (page 4, line 10-page 5, line 8; page 7, line 10-page 8, line 6; and page 8, line 9-page 9, line 11) where it is obvious that the second address must be communicated so the destination unit can complete the call correctly. Blair does not disclose instructions for a computer-readable medium; however, it is well known to implement a method using software rather than hardware because software offers greater flexibility, as is evidenced by Movshovich (col. 4, lines 44-57). It would have been obvious to one of ordinary skill in the

art at the time of the invention to implement the system using software because software is more flexible than hardware.

29. Regarding claim 29, referring to claim 25, Blair in view of Movshovich discloses that the identifier in the call setup message is an address (telephone number) of the second terminal (Blair: page 7, line 2 to page 8, line 5 and lines 15-19).

30. Referring to claim 30, referring to claim 29, Blair in view of Movshovich does not expressly disclose that the address of the second terminal includes a country code and said address is determined to correspond to the predetermined location information if the country code corresponds to a country serviced by the alternative network; however, Blair in view of Movshovich does disclose that the telephone number is used in a long-distance telephone call (Blair: page 7, line 2 to page 8, line 5 and lines 15-19). Examiner takes official notice that it is very well-known in the art to include a country code with a telephone number when making a long-distance call in order to specify a country for a call. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the address of the second terminal include a country code and to have the address be determined to correspond to the predetermined location information if the country code corresponds to a country serviced by the alternative network in order to allow calls to be placed to a specific country.

31. Claims 26 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692) in view of Movshovich (USPN 5,608,425) as applied to claims 25 and 47 above, and further in view of Cisneros (USPN 5,130,984) in view of Lyon et al (USPN 5,892,924).

32. Regarding claims 26 and 48, referring to claims 25 and 47, Blair in view of Movshovich discloses that the primary network could be an integrated services digital network (ISDN) (Blair: page 9, lines 18-19). ISDN networks are well known in the art as a way to provide increased bandwidth compared to POTS, as is evidenced by Cisneros (col. 1, lines 30-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to use ISDN for the primary network in order to take advantage of the increased bandwidth that ISDN provides compared to POTS. Blair in view of Movshovich in further view of Cisneros teaches that the alternative network is the Internet (Blair: page 4, lines 10-20). Blair in view of Movshovich in further view of Cisneros does not disclose that the alternative network is an asynchronous transfer mode (ATM) network. Lyon teaches that ATM is "a highly efficient packet-forwarding technology with very high throughput, scalability, and support for multiple types of traffic including voice and video as well as data" (col. 2, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to use an ATM network instead of an IP network because ATM offers very high throughput, scalability, and support for multiple types of traffic including voice and video as well as data.

33. Claims 28 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blair et al (WO 97/27692) in view of Movshovich (USPN 5,608,425) as applied to claims 25 and 47 above, and further in view of Roy (USPN 6,026,080).

34. Regarding claims 28 and 50, referring to claims 25 and 47 and claim rejections of claim 26, Blair in view of Movshovich does not disclose that the first and second terminals conform to ITU-T Recommendation H.320. Roy discloses that ITU-T Recommendation H.320 is a well-known international standard for video conferencing for use on an ISDN network (col. 1,

Art Unit: 2665

lines 27-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to have the first and second terminals conform to ITU-T Recommendation H.320 in order to allow video conferencing over the network.

Allowable Subject Matter

35. Claims 4, 5, 11, 20, 27, 34, 42, 45, and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not disclose or fairly suggest having the data channel be an ISDN B-Channel. Claims 4, 11, 20, 27, 34, 42, 45, and 49, in view of the claims upon which these claims depend, disclose that the data channel is used to transmit signaling information (claims 4, 20, 27, 34, and 45: the identifier of the second terminal; claim 11: call setup information concerning the second terminal; and claims 42 and 49: message indicating establishment of a connection). In the prior art, all signaling is conducted over the ISDN D-Channels. As such, the prior art does not disclose or fairly suggest having the data channel be an ISDN B-Channel where the data channel is used to transmit signaling messages.

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lakhani et al. (USPN 6,757,285) see entire document which pertains to communicating ISDN information over an ATM backbone. Shenoda et al. (USPN 6,389,130) see entire document which pertains to communicating ISDN information over an ATM backbone. Rao et al. (USPN 5,375,118) see entire document which pertains to communicating ISDN information over an ATM backbone.

Art Unit: 2665

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Ryman whose telephone number is (571)272-3152. The examiner can normally be reached on Mon.-Fri. 7:00-4:30 with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

0012

Daniel J. Ryman
Examiner
Art Unit 2665



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